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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/597,942

10/03/2006

Martinez-Miranda Eduardo

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INTELLECTUAL PROPERTY LAW GROUP LLP  
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SUITE 1205  
SAN JOSE, CA 95113

EXAMINER

REAGAN, JAMES A

ART UNIT

PAPER NUMBER

3621

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,942	<b>Applicant(s)</b> EDUARDO ET AL.	
	<b>Examiner</b> JAMES A. REAGAN	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/27/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☒ Claim(s) 4-16, 20-28 and 32-40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/11/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the application filed on application received on **10/03/2006** and subsequent preliminary amendment received on **5/27/2008**.
2. Claims 41-43 have been canceled.
3. Claims 1-40 are currently pending and have been examined.

### **Information Disclosure Statement**

4. The Information Disclosure Statement filed on **8/11/2006** has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### **Claim Objections**

5. Claims 4-16, 20-28, and 32-40 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiply dependent claim. See MPEP § 608.01(n). Accordingly, the claims 4-16, 20-28, and 32-40 not been further treated on the merits.

### **Claim Rejections - 35 USC § 112**

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1, 3, 17, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner cannot determine the metes and bounds of the claim because the claim has been written in the alternative using an "or" statement. For the purposes of this examination, the Examiner will assume that the claim is a properly written Markush-type limitation: *...one of the group consisting of [A, B, **and** C].*
8. Claims 29 and 31 recite the limitations *the assigned account, the assigned account status, the unique identifier, and the communications message*. There is insufficient antecedent basis for this limitation in the claim.

#### **Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
12. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar (US 2005/0065876 A1), hereinafter **KUMAR**, in view of Dunn et al. (US 2007/0021975 A1), hereinafter **DUNN**.

**Claim 1:**

**KUMAR** as shown below discloses the following limitations:

- *a payments facilitator; (see at least paragraph 0021)*
- *a plurality of accounts established by the payments facilitator, each account being operable to hold a monetary value equivalent on trust for a customer; (see at least paragraphs 0021 and 0022)*
- *where, when a payer sends a communication message to the payments facilitator to make a payment to the party, the payments facilitator allocates one of the unused accounts to the party, changes its status to assigned, and links the allocated account with a unique identifier assigned to the party, the payment thereafter being made to the allocated account; (see at least paragraph 0059)*
- *where, when the party redeems the payment, the account status is changed to inactive by the payments facilitator, and subsequently after elapse of a predetermined period of time, the account status is changed to unused by the payments facilitator (see at least paragraph 0059)*

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**KUMAR** does not disclose the limitation of *each account of said plurality of accounts having a status of unused, assigned, or inactive*. However, **DUNN**, in at least paragraph 0123 discloses account status and the ability to change account status' between three choices. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the temporary account techniques of **KUMAR** with the account status technique of **DUNN** because this provides an indication of whether an account is available for use.

**Claims 17 and 29:**

The combination of **KUMAR/DUNN** discloses the limitations as shown in the rejections above. The remaining claims (17 and 29) refer to the corresponding system, method and/or software claims to the previous claim (1) and hence the same above citations and rejections are applied.

**Claims 2, 18, and 30:**

The combination of **KUMAR/DUNN** discloses the limitations as shown in the rejections above. **KUMAR** further discloses *the plurality of accounts are established with at least one financial institution*. See at least paragraph 0021.

**Claim 3:**

The combination of **KUMAR/DUNN** discloses the limitations as shown in the rejections above. **KUMAR** further discloses *the payments facilitator being, or being associated with, a telecommunications carrier*. See at least paragraph 0010.

**Claim 19:**

The combination of **KUMAR/DUNN** discloses the limitations as shown in the rejections above. **KUMAR** further discloses *operable to assign the party's phone number as the unique identifier*. See at least paragraph 0043.

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**Claim 31:**

The combination of **KUMAR/DUNN** discloses the limitations as shown in the rejections above. **KUMAR** further discloses *identifying the unique identifier of the party from either the communication message and/or a destination address to which the communication message is sent*. See at least paragraph 0014.

**Claims 4-16, 20-28, and 32-40:**

Although claims 4-16, 20-28, and 32-40 have not been evaluated on their merits, these claims depend from rejected base claims, and are hereby rejected under the combination of **KUMAR/DUNN** as well.

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### **Conclusion**

13. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ANDREW J. FISCHER** can be reached at **571.272.6779**.
14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
15. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to **571-273-8300**.

16. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/James A. Reagan/

Primary Examiner, Art Unit 3621